

As described in the specification, this novel tape is useful for the flying splice technique of replacing an almost fully unwound roll of paper with a new roll without having to stop the machine which is working with the rolls of paper.

Claims 1-17 stand rejected under 35 U.S.C. 103(a) as obvious over Wienberg, the U.S. equivalent of DE 19628317, either individually or in view of the Handbook of Adhesives.

As the Examiner sees it, Applicants' claimed tape differs primarily in its selection of a film, as opposed to a paper backing. The Examiner indicates that he "**believes:** that one of ordinary skill is aware of both the advantages and disadvantages of both paper and film. Alternatively, the Examiner cites page 725 of the Handbook of Adhesives as teaching that paper and film backings are often used interchangeably in the art.

The Examiner may have misread the Handbook, however. Nowhere at page 725 does the Handbook teach that paper and film backings are **interchangeable**. To the contrary, a fair reading of page 725 will show that paper and film backings are used **differently**, have to be treated **differently** and have **different properties**.

Thus, those skilled in the art reading the Handbook reference would never substitute a paper backing for a film backing or a film backing for a paper one for any particular use. Those skilled in the art reading page 725 would understand that paper is appropriate for certain applications, because of its properties, while film is appropriate for others.

The Wienberg reference is quite emphatic in stressing that the adhesive tape disclosed therein must have a paper backing (see col. 1, line 48).

The Example of Weinberg teaches the use of *crepe paper* (see col. 3, line 34).

No person skilled in the art would see film as "interchangeable" with crepe paper.

Of greater importance, however, is the fact that there is nothing in the Weinberg reference that would suggest, or even allow, a film backing. The adhesive tape of the Weinberg reference is for a specific use, and nothing in either reference would suggest that a film backing could or should be substituted for Weinberg's paper backing, or that such a backing would even be workable in Weinberg's use.

In the absence of any suggestion that would lead to Applicants' claimed tape in this combination of references, Applicants' tape cannot fairly be seen as obvious over this combination of references, and the rejection of claims 1-17 under 35 U.S.C. 103(a) as obvious over Wienberg, the U.S. equivalent of DE 19628317, either individually or in view of the Handbook of Adhesives should now be withdrawn.

Claims 1-17 are also provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12 of copending application no 09/518,463 or 09/490,709 in view of the Handbook of Adhesives, Second Edition (1977), chapter 47. Here, as in the previous rejection, the Examiner contends that

the claims are substantially identical except for Applicants claiming a film backing instead of the paper backing shown by each of the cited applications. The Examiner again relies on the Handbook of Adhesives for what he refers to as "showing the well known at least partial equivalence of film versus paper backings in the adhesive tape art".

As discussed above, however, the Handbook of Adhesives teaches exactly the opposite of "equivalence" of paper and film. There are film backings and there are paper backings; each of which has specific properties which lend them useful for specific applications, and each of which has to be treated differently. Thus, the Handbook of Adhesives teaches that paper backings used with pressure-sensitive adhesives are almost universally impregnated with some sort of rubbery material. Films, on the other hand, are usually coated with a primer, according to the Handbook, to improve the bonding of the adhesive.

Thus, film backings are not at all "equivalent" to paper backings, and neither suggests the other in the context of the 09/518,463 and 09/490,709 applications, which concern adhesive tapes for specific uses which require specific properties and capabilities. There is nothing in either reference that would suggest that film could be substituted for the paper backings in the disclosed use. There is therefore no motivation to make such a change.

In the absence of some suggestion or motivation to make the changes necessary to arrive at Applicants' novel tape, the rejection of claims 1-17 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12 of

copending application no 09/518,463 or 09/490,709 in view of the Handbook of Adhesives, Second Edition (1977), chapter 47 should now be withdrawn.

Claims 1-17 stand provisionally rejected under 35 U.S.C 103(a) as obvious over copending applications 09/518,446 or 09/490,709, each in view of the Handbook of Adhesives reference.

Although the Examiner does not provide a detailed explanation of what he sees in each of these references that he contends renders Applicants' claims obvious, the Examiner does indicate that he repeats the combination rejections ...as was earlier set forth.

This rejection is therefore made upon the same reasoning as the previous one, and Applicants' explanations of why the previous rejection is not correct and should be withdrawn are equally applicable here, and are incorporated herein by reference.

The provisional rejection of claims 1-17 under 35 U.S.C 103(a) as obvious over copending applications 09/518,446 or 09/490,709, each in view of the Handbook of Adhesives reference should accordingly now be withdrawn.

In view of the present amendments and remarks it is believed that claims 1-17 are now in condition for allowance. Reconsideration of said claims by the Examiner is respectfully requested and the allowance thereof is courteously solicited.

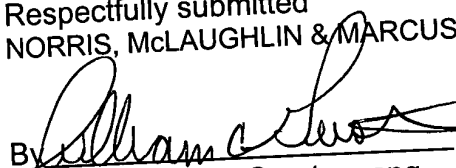
CONDITIONAL PETITION FOR EXTENSION OF TIME

If any extension of time for this amendment is required, applicants request that this be considered a petition therefore. Please charge the required petition fee to Deposit Account No. 14-1263.

ADDITIONAL FEE

Please charge any insufficiency of fee or credit any excess to Deposit Account No. 14-1263.

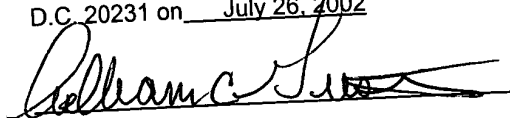
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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to : Assistant Commissioner for Patents, Washington, D.C. 20231 on July 26, 2002



Date July 26, 2002

**MARKED-UP COPIES OF AMENDED CLAIMS
SHOWING CHANGES RELATIVE TO PREVIOUS VERSIONS**

- Claim 1 (twice amended). An adhesive tape with adhesive front side and nonadhesive rear side and two long edges for flying reel change, having
- a) a film backing (P1) having a front side and a rear side and which is coated on the front side with a self-adhesive composition (N1),
 - b) part of the nonadhesive rear side of the film backing (P1) being equipped with a double-sided adhesive tape (DO) which [has, on one side,] **is comprised of** a cleavable system (P2) coated on both sides with self-adhesive composition (N2, N3), wherein
 - c) the double-sided adhesive tape (DO) is arranged at a distance (V) of 0-15 mm, from one long edge (LK) of the adhesive tape.